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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,140	01/25/2001	Spencer A. Rathus	660-022	8419

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EXAMINER
KIM, AHSHIK

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,140	RATHUS ET AL.	
	Examiner	Art Unit	
	Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/15/03 (Amdt & TD)* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *168-301* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *168-301* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Terminal Disclaimer

1. Provisional terminal disclaimer filed on April 15, 2002 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Application Serial No. 09/769,149 to Rathus et al. has been reviewed and is accepted. The terminal disclaimer has been recorded (paper #10).

2. Terminal disclaimer filed on April 22, 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 5,932,863 to Rathus et al. has been reviewed and is accepted. The terminal disclaimer has been recorded (paper #11).

Amendment

3. Receipt is acknowledged of the amendment filed on April 22, 2003. In the amendment, claims 211, 222, 280-282, 289-296, 298, 299, and 301 were amended. Currently, claims 168-301 remain for examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 168-201, 204-206, 223-224, 240, 249-256, 261-264, 267-270, 275-277, 280, 291, 296, and 298-301 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al. (US 4,488,035, "Whitnall" hereafter) in view of Fields (US 4,481,412) and Li et al. (US 5,506,697, "Li" hereafter).

Re claims 168, 193-201, 204-206, 223-224, 240, 267-270, 275-277, 280, 291, 296, and 298-301: Withnall discloses a system for displaying information to a user comprising a printed document, which is a travel ticket (e.g., train, bus, etc.) having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having

associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall in order to provide Withnall with a higher technology system wherein the user being provided with a variety of information in flexible ways (i.e., video, pictorial, etc.). Furthermore, such modification would have been an obvious extension as taught by Withnall, and therefore an obvious expedient.

Withnall as modified by Fields fails to teach or fairly suggest that the printed document is an official document.

Li teaches the above limitation with printed document 220 is an official document, which is a tax return in this case (figs. 9 & 10; col. 7, lines 30-45).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Li into the teachings of Withnall/Fields in order to provide Withnall/Fields with a more secure system wherein official documents can be prevented from being accessed by an unauthorized person due to the benefit of a machine

recognizable symbol/barcode, and thus providing a more user-friendly system wherein the user does not have to be concerned about whether the user's lost/stolen official document is read by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields, and therefore an obvious expedient.

Re claims 169-192, 249-256, and 261-264: Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest that the printed official document is a license, a registration, a passport, a, visa, a green card, a license plate, a tag, a decal, a parking permit, a social security card, a health insurance card, a Medicaid card, a deed, a invoice, a receipt, a bill of sale, a library card, a newsletter, a application form, a lottery ticket, etc.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the printed official document as taught by Withnall/Fields/Li as a license, a registration, a passport, etc. wherein the modification has been merely a substitution of a functional equivalent which does not change the underlying inventiveness of Withnall/Fields/Li's teachings. Furthermore, such modification would have been an obvious design variation as taught by Withnall/Fields/Li , and therefore an obvious expedient.

7. Claims 202, 203, 208, 209, 210, 212, 217, 218, 220, 221 and 242-247 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claim 168 above, and further in view of Roberts (US 5,324,922) and Malec et al. (US 5,287,266, "Malec" hereafter). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 202, 203, 208, 209, 210, 212, 217, 218, 220, 221, and 242-247: Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall/Fields/Li with a faster Internet system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li to provide the user with an alternative way of conducting shopping at his/her convenience (i.e., online shopping/at home), and therefore an obvious expedient.

Withnall/Fields/Li as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec teaches the above limitation with the use of ISDN technology (col. 7, lines 112).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec into the teachings of Withnall/Fields/Li/Roberts in order to provide Withnall/Fields/Li/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking line. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li/Roberts and would have merely been a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

8. Claims 207, 210, 214-216, 219, 222, 227-229, 231-232, 237-238, 241, 249-260, 265-266, 274, 279, 281-283, 294, and 297 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claims 168 and 296 above, and further in view of Bravman et al. (US 5,401,944, "Bravman" hereafter). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 207, 210, 214-216, 219, 222, 227-229, 231-232, 237-238, 241, 249-260, 265-266, 274, 279, 281-283, 294, and 297: Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest that the display unit comprising a wireless communication device (e.g., a remote unit).

Bravman teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through co]. 14, line 5 and col. 16, line 14 through col. 18, line 22.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman into the teachings of Withnall/Fields/Li in order to provide Withnall/Fields/Li with a more flexible system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li, and therefore an obvious expedient.

9. Claims 225, 230, and 233 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claim 168 above, and further in view of

Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 225, 230, and 233, Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Li in order to provide Withnall/Fields/Li with an improved security system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, and thus preventing an unauthorized individual) from manipulating the data. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li, and therefore an obvious expedient.

10. Claims 226 and 240 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claim 168 above, and further in view of Tannehill et al. (US 5,158,310, "Tannehill" hereafter). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 226 and 240, Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill teaches the above limitation with the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill into the teachings of Withnall/Fields/Li in order to provide Withnall/Fields/Li with an alternative feature for encoding data. Furthermore, such modification would have been merely a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

11. Claims 234-236 and 239 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claim 168 above, and further in view of Schach et al (US. 5,397,156, "Schach" hereafter) and Anmelder (DT 2,452,202 A1). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 234-236 and 239, Withnall/Field/Li have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a watermark.

Schach teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach into the teachings of Withnall/Fields/Li et al for its aesthetic purposes. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li, and therefore an obvious expedient.

Withnall/Fields/Li as modified by Schach fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall/Fields/Li/Schach in order to provide Withnall/Fields/Li/Schach with a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li/Schach and therefore an obvious expedient.

12. Claims 213, 271-2,73, 278, 279, 284-290, 292, 293, and 295 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Li as applied to claim 168 above, and further in view of Morales (US 5,872,589). The teachings of Withnall as modified by Fields/Li have been discussed above.

Re claims 213, 271-273, 278, 279, 284-290, 292, 293, and 295: Withnall/Fields/Li have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall/Fields/Li in order to provide the user with the flexibility of selecting his/her desired display unit that is more suitable for his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Li, and therefore an obvious expedient.

Response to Arguments

13. Applicants' amendment and remarks filed on April 16, 2003 have been given careful consideration, but they are not persuasive in view of the rejection stated above.

With respect to the rejection under 35 U.S.C. 103(a), Applicant argues (See page 19, 3rd paragraph thereafter) essentially that the cited references in combination fail to specifically teach or fairly suggest the subject matter disclosed in instant application.

Although Applicants' embodiment may be different from disclosures shown in these references, it is Examiner's opinion that the cited references, in combination, teach the claimed invention of instant application. For example, claim 168 recites "A system for displaying programming material to a user, the system comprising: a printed official document having at least one machine recognizable feature; a feature recognition unit having associated therewith a means for recognizing said machine recognizable features and a means for transmitting a coded signal in response to the recognition of said machine recognizable feature; an intelligent controller having associated therewith a means for accessing said programming material in response to receiving said coded signal; and a display unit for presenting said programming material." Other independent claims 296 and 299 recite similar methods (although scope of claim 296 seems broader than claim 299).

The Withnall patent discloses a printed matter having one machine recognizable feature such as barcode; a feature recognition unit; and a portable handset displaying information to the users. Without borrowing the subject matter disclosed in the Fields patent, it is Examiner's view that travel information which can be retrieved once barcode on the ticket has been read can be considered programming material (see Withnall, col. 5, lines 14+) associated with the barcode.

It is also the Examiner's view that a fair ticket disclosed in Withnall is a printed official document.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Withnall and the secondary references to Fields and Nobles are directed to a printed matter (i.e., tickets, textbooks, etc.) comprising an indicia, which is used for programming and further processing. Accordingly, it is Examiner's view that the motivations, which are within one ordinary skill in the art, to improve the primary reference to Withnall have been provided.

Although double patenting rejection has been overcome by filing of terminal disclaimer (Papers #10 and #11), the claims are broadly recited such that the cited references, taken alone or in combination, teach the claimed invention.

Applicants' amendment and remarks describing these elements have been carefully studied and considered, but they are not persuasive. Therefore, Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
August 18, 2003

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